

REMARKS

The supplemental first Office action mailed on 14 September 2005 (Paper No. 20050824) has been carefully considered.

The specification and Abstract are being amended to correct minor errors and improve form. Claims 5, 6, 10, 12, 15, 16 and 20 are being canceled without prejudice or disclaimer, claims 1 thru 4, 7 thru 9, 11, 13, 14, 17 thru 19 and 21 are being amended, and new claim 22 is being added. Thus, claims 1 thru 4, 7 thru 9, 11, 13, 14, 17 thru 19, 21 and 22 are pending in the application.

In addition, Figure 6 is being amended. Specifically, reference numeral 141 is being changed to 141' so as to conform to the amendments made to the specification. Substitute formal Figure 6 which incorporates this change accompanies this Amendment. Entry of substitute formal Figure 6 and confirmation of the entry in writing in the next Office action are respectfully requested.

In paragraph 2 of the Office action, the Examiner rejected claim 17 under 35 U.S.C. §112 (second paragraph) for lack of antecedent basis. In response, claim 17 (line 5) is being amended to replace the term "the additional function" by the term "a non-voice communication mode function". Accordingly, the rejection under 35 U.S.C. §112 (second paragraph) no longer applies, and should be withdrawn.

In paragraph 4 of the Office action, the Examiner rejected claims 1 thru 6 and 12 thru 21 under 35 U.S.C. §102 for alleged anticipation by Okada *et al.*, U.S. Patent Publication No. 2003/0100347. In paragraph 6 of the Office action, the Examiner rejected claims 7 thru 11 under 35 U.S.C. §103 for alleged unpatentability over Okada *et al.* '347 in view of Barnes Jr., U.S. Patent Publication No. 2005/0136949. For the reasons stated below, it is submitted that the invention recited in the claims, as now amended, is distinguishable from the prior art cited by the Examiner so as to preclude rejection under 35 U.S.C. §102 and/or §103.

The primary reference cited by the Examiner, Okada *et al.* '347, discloses an electronic apparatus having game and telephone functions. More specifically, Okada *et al.* '347 relates to an electronic apparatus for interrupting a game when receiving an incoming telephone call. In such a game phone, when the game is operated by the user of the phone and an incoming call is received, Okada *et al.* '347 suggests that the game data be saved into memory, and that the game be resumed after the call is completed. Thus, Okada *et al.* '347 merely suggests a simple "pause" function of the game mode in the game phone.

On page 3 of the Office action, the Examiner alleges that Okada *et al.* '347 discloses a multi-purpose hybrid terminal (that is, an electronic apparatus having game and phone functions). The Examiner further alleges that Okada *et al.* '347 discloses an

apparatus which comprises an input section for receiving a user's demand to implement an additional function while the hybrid terminal remains in a phone mode accommodating performance of a communication function (that is, operation of a game start key causes a shift from a phone mode to a game mode, and the device can still detect an incoming call). In the latter regard, the Examiner cites page 3, paragraphs 76 and 78 of the patent.

The Examiner further alleges (on page 3 of the Office action) that Okada *et al.* '347 discloses a memory for storing the demand of the user (citing page 1, paragraph 9 of the patent). However, a review of paragraph 9 on page 1 of the patent reveals that the only thing that is stored in memory is the game data. Thus, Okada *et al.* '347 does not disclose or suggest a memory for storing the demand of the user, as recited in the claims of the present application.

Turning to consideration of paragraph 76 on page 3 of Okada *et al.* '347, as cited by the Examiner, that paragraph discloses that, if the operator operates the game start key 20 in the incoming call stand-by state, an operation mode is shifted from a phone mode to a game mode. It is further stated that, first, a menu screen shown in Figure 3 is displayed. When the operator selects a desired game from the menu screen, the selected game is started. The display on the LCD 18 is renewed to a game screen shown in Figure 4, and a BGM is outputted from the speaker 48 on the back surface. The game then proceeds in response to operation of the game key 22, and a sound effect is outputted from the

speaker 48 as necessary.

Considering paragraph 78 on page 3 of Okada *et al.* '347, also cited by the Examiner, it is disclosed that, even if the game is in progress, detection of the incoming call is executed. It is further disclosed that, when there is an incoming call, the motion of the game screen is stopped and the output of the BGM is interrupted. That is, the game is paused in response to the incoming call. Furthermore, the ring tone is outputted from the speaker 48 in place of the BGM, and the display of the LCD 18 is renewed to an incoming call screen as shown in Figure 5. According to Figure 5, a tone of the game screen is changed, and an incoming call message of "IN INCOMING CALL" and the telephone number of the transmission source are displayed on the game screen. In addition, at this point, the output of the ring tone is interrupted by operation of the hook key 24a, and the protocol is established, leading to a communication enable state. After the communication is completed, the tone of the game screen is restored, and the game screen shown in Figure 4 is displayed again.

Thus, the portions of Okada *et al.* '347 pointed out by the Examiner describe the general "mode shift" operation, stated as follows:

"If the operator operates the game start key 20 in the incoming call stand-by state, an operation mode is shifted from a phone mode to a game mode" (quoting from the first sentence in paragraph 76 on page 3 of the patent).

However, the arrangement of Okada *et al.* '347 does not include an input section as recited in independent claims 1 and 4 of the present application. In accordance with the present invention, an input section receives a user's preset or set-up demand or command relative to how to implement an additional function. This input section element is completely different from the conventional mode shift or switching operation disclosed in Okada *et al.* '347. This difference is supported by the description of the invention which, for example, states (in paragraph 58 of the present application) as follows:

"The user can input the demand by various methods, such as with a series of key inputs through manual manipulation of one or more of the several keys borne by keypad 163, in response to the visual and textual prompts provided by the visual images projected by display section 157, with, for example, screen 101 or 103, as shown in FIG. 3."

In particular, it should also be noted that Okada *et al.* '347 does not disclose or suggest the input of a user demand to set up a non-voice communication function or non-voice communication function mode.

Another difference between the present invention and the prior art relates to the function of the monitoring section recited in independent claims 1 and 4. As recited in the claims, the monitoring section monitors whether a condition that satisfies the demand of the user is met while the terminal remains in a voice communication mode (*see* claims 1 and 4). In this regard, the Examiner alleges that the interrupting means of Okada *et al.*

'347 is similar to the monitoring section of the present invention. However, in Okada *et al.* '347, the interrupting means simply monitors the occurrence of an interrupt, which is universal with respect to each and every user. This does not constitute, however, the monitoring of a condition to determine whether the condition satisfies the demand or request of a user. Moreover, the condition to be monitored in Okada *et al.* '347 is firmly fixed, and cannot be changed based on the demand of a user. In contrast, in the present invention, each user has the freedom to set up his or her own condition to be monitored so as to determine whether that condition is met.

Turning to consideration of independent method claim 13, that claim also recites steps which distinguish the invention from the prior art cited by the Examiner. Specifically, step (a) distinguishes the invention from Okada *et al.* '347 because the latter patent does not disclose or suggest the step of receiving and storing a demand of a user to set up a non-voice communication function. Furthermore, with respect to step (b) of the recited method, Okada *et al.* '347 does not disclose or suggest the step of monitoring whether a condition that satisfies the demand of the user is met. As mentioned above, the interrupting means of Okada *et al.* '347, as cited by the Examiner, merely monitors to determine whether an interrupt, unrelated to any demand from the user, occurs.

Further considering claim 13, step (c) further distinguishes the invention from Okada *et al.* '347 because the latter patent does not disclose or suggest the performance

of at least one task for implementing a non-voice communication function when a condition that satisfies the demand of the user is met. Thus, for the above reasons, independent claim 13 is distinguishable from the prior art so as to preclude rejection under 35 U.S.C. §102 or §103.

Independent claim 17 further distinguishes the invention from the prior art because Okada *et al.* '347 does not disclose or suggest a computer-readable medium bearing instructions, wherein the instructions include storing a demand from a user for the hybrid terminal to implement a non-voice communication mode. Furthermore, Okada *et al.* '347 does not disclose or suggest instructions comprising the making of a determination as to whether a condition specified by the demand of the user has been met, as well as the performance of at least one task for implementing a non-voice communication mode function when the determination establishes that the user-specified condition has been met. For this reason, independent claim 17 is distinguishable from the prior art so as to preclude rejection under 35 U.S.C. §102 or §103.

Finally, with respect to the citation of the secondary reference, Barnes Jr. '949, whereas that patent application publication discloses a portable communication device and method of use, there is no evidence on the record to establish the fact that a person of ordinary skill in the art, upon reviewing the primary reference, Okada *et al.* '347, would be sufficiently motivated or instructed to seek and obtain the disclosure of Barnes Jr.

'949 so as to render the claimed invention obvious under 35 U.S.C. §103.

In the latter regard, on page 10 (second paragraph) of the Office action, the Examiner states that "motivation for doing so would have been to provide to the device the added ability to contemporaneously maintain a wireless voice and data link". However, the Examiner does not cite any portion of Okada *et al.* '347 which would provide a person of ordinary skill in the art, upon reviewing that reference, sufficient motivation. In fact, the expression of motivation on the part of the Examiner on page 10 of the Office action constitutes the mere expression of an opinion on the part of the Examiner, without any extrinsic evidence in support thereof.

The same or similar comments supply to other statements of "motivation" set forth by the Examiner in the Office action. *See*, for example: page 10, sixth paragraph; page 11, second paragraph; page 12, third and seventh paragraphs.

To summarize, the rejection under 35 U.S.C. §102 based on the disclosure of Okada *et al.* '347 is clearly inappropriate since Okada *et al.* '347 does not disclose each and every element, function or step recited in the independent claims of the present application. Furthermore, even with the combination of Okada *et al.* '347 and Barnes Jr. '949, the resultant combined disclosure does not contain or suggest each and every element, step and function recited in the independent claims of the present application.

Finally, as stated above, there is no evidence on the record (excluding the statement of an opinion on the part of the Examiner) to suggest that one of ordinary skill in the art, upon reviewing Okada *et al.* '347, would receive sufficient instruction and/or motivation to seek and obtain the disclosure of Barnes Jr. '949, and to know how to combine the disclosures of those two references so as to arrive at the present invention. In the latter regard, it is noted that the Examiner has had the benefit of reviewing the disclosure of the present application, and thus, the Examiner has an advantage which one of ordinary skill in the art, as of the date of the invention, would not have, that is, the advantage of seeing how the present Applicant has developed the present invention.

To summarize, the rejections under 35 U.S.C. §102 and §103 are clearly inappropriate, and thus, it is respectfully requested that these rejections be withdrawn.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

No fee is incurred by this Amendment.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "R. E. Bushnell", written over a horizontal line.

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